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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,124	08/27/2003	Steven R. Reznick	03073	5523

7590 11/05/2007
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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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11/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,124

Applicant(s)

REZNEK ET AL.

Examiner

Lyle A. Alexander

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3-5 and 7-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. One having ordinary skill in the art would not be able to make and or use the invention as presently claimed. Below are examples of some of the 35 USC 112-second paragraph issues with the instant claims.

Claim 1 is not clear what method is contemplated. It is not clear what is intended by "creating" and "a product specification".

Claim 4 is confusing what method "specifying" performs. Are Applicants' actually measuring/testing anything or merely recording product information. Is the "determining" step a mental process ?

Claim 5 is confusing what method is performed by the claimed "determining comprises".

Claims 6-7,10 are confusing what is intended by the "specifying comprises characterizing..." and "specifying". Is there any analyses performed or are these mental steps.

Art Unit: 1797

Claims 8,11 are confusing what method is being performed by "... the morphological value is included on a product specification sheet ...". Are Applicants' claiming recording product specifications on a sheet ?

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3-5 and 7-25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mansky (US 2003/0097871).

See the appropriate paragraph of the 2/9/07 Office action.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 8/2/07 is acknowledged. The traversal is on the ground(s) that all of the groups have overlapping subject matter and there would be no serious burden imposed upon the PTO. This is not found persuasive because the criteria for a restriction requirement are if there is more than one independent and distinct invention. The Office has shown there is more than one independent and distinct invention in the 2/9/07 restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

There do not appear to be copies of the non-considered references from the previously considered PTOL-1449's scanned into the file for consideration. The Office regrets any inconvenience caused to Applicants, but if Applicants were to provide the references in question, the Office will consider the references.

Response to Arguments

Applicant's arguments filed 8/2/07 have been fully considered but they are not persuasive.

Applicants traverse the 35 USC 112 second paragraph rejections stating the claim language has plain and unambiguous meaning. The Office maintains claim 1 is not clear what method is contemplated (e.g. how is the product specification created? what is the product specification ?) Claims 3-5 are not clear what type of information is being specified/determined (e.g. how can the properties on a product sheet, purchase order, invoice, contract, etc. be specified ? also how would one having ordinary skill in the art determine what the properties are product sheet, purchase order, invoice, contract, etc. to perform the claimed method ?) With respect to claims 7 and 10, the Office has considered paragraphs[33-36] of the original specification and maintains these claims are unclear how and which of the numerous methods are intended.

Applicants traverse 35 USC 102 rejections over Mansky on the basis this reference fails to address the claimed invention of screening an array of materials for mechanical properties. In the absence of better defining what properties are measured/determined, the Office maintains the rejections of record are proper.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patel et al. (USP 4,740,319 teach a method of calculating the Bringham yield of a fluid.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1797

